

REMARKS

Claims 1-10 and 12 are pending in this application. All of these claims stand rejected. The Applicant respectfully requests reconsideration of the rejections of the claims in view of the following remarks.

Claim 11 was again indicated as rejected in the present Office Action. This claim, however, was cancelled in the last amendment filed on May 28, 2003. Thus, this rejection is moot.

Claims 1-10 and 12 were finally rejected under 35 U.S.C. §103(a) as being unpatentable over *Bandara* (U.S. Patent No. 5,899,973) in view of *Matsumoto et al.* (U.S. Patent No. 5,848,390). The Applicants respectfully traverse this rejection and request reconsideration for the following reasons.

With respect to claims 1 and 12, the Office Action repeats the previously made assertion that *Bandara* discloses a method for voice recognition in which spoken language is recognized using a voice recognition system, and includes the claimed element of "running the voice recognition system on a computer." The Office Action again acknowledged that *Bandara* does not disclose a method that includes elements b) through d) of independent claim 1. *Matsumoto* was then relied upon as allegedly teaching the elements missing from *Bandara*. The Office Action asserts that it would have been obvious to one of ordinary skill in the art to modify the method of voice recognition of *Bandara* to further include determining a performance index of the computer by a program for computer performance assessment for the purpose of tailoring the voice recognition system to the particular system on which it is run, based on the teachings of *Matsumoto*.

The Applicant again maintains that the rejection set forth in the present Office Action does not establish a *prima facie* case of obviousness. In particular, the Applicant respectfully submits that one of ordinary skill in the art would not perceive suggestion or proper motivation to modify *Bandara* to include features taught by *Matsumoto*. In response to Applicant's previous arguments, the present Office Action asserts that *Matsumoto* is relied upon only for teachings related to tailoring a signal processing methodology, whether that be speech synthesis or voice recognition, to a particular system (i.e., computer) running that application.

Notwithstanding, the Applicant respectfully submits that, although the Patent Office is not limited to the same motivations to combine references as that of the Applicant, the Office is still bound to meet the requirements of establishing a *prima facie* case of obviousness. In particular, when modifying a reference in a combination of references, the prior art still must suggest the desirability to one of ordinary skill in the art to combine or modify the references (see MPEP, §2143.01). The fact that references can be combined or modified is not sufficient to establish a *prima facie* case of obviousness when the prior art does not suggest the desirability of the combination, regardless of the "motivation" manufactured by the Patent Office.

In this particular case, *Bandara* teaches a speech recognition system that employs a particular algorithm discarding n-grams that an acoustic part of the system can recognize most accurately without support from a language model. *Bandara* teaches that this decrease in size of the statistical language model in speech recognition systems is performed in order to reduce needed resources of such systems. When considering these teachings of *Bandara* as a whole (the standard being mandated as a basic consideration when applying obviousness rejection), one of ordinary skill in the art would not perceive any suggestion that it would be desirable to incorporate a completely different methodology as that disclosed in *Matsumoto* in order to accomplish the object of *Bandara*. Again, merely because these references might be combinable, is not enough to establish obviousness when the desirability of the combination is lacking in this case. The method of *Bandara*, through a particular algorithm, seeks to reduce needed resources without adjusting or degrading the accuracy of a speech recognition system. Thus, it would not make sense to further cobble the teachings of *Matsumoto* with *Bandara*, which would effect a reduction in the accuracy of the speech recognition system of *Bandara*, thereby vitiating a purpose of *Bandara* (see *Bandara*, column 3, lines 11-55). Accordingly, the Applicant respectfully submits that a *prima facie* case has not been properly established in the rejection of claims 1 and 12 and that this rejection should be withdrawn.

In light of the above, Applicant respectfully submits that independent claim 1, as well as claims 2-10 which respectfully depend therefrom, are both novel and non-obvious over the art of record.

In light of the foregoing, the Applicant submits that the present application is in condition for allowance and requests that a timely Notice of Allowance be issued in this case.

It is further acknowledged that no fees are due in connection with this response at this time. However, if any fees are due in connection with this application as whole, the office is hereby authorized to deduct said fees from Deposit Account No. 021818. If such a deduction is made, please indicate the attorney docket number (112740-434) on the account statement.

Respectfully submitted,

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